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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/712,302	09/11/96	GROTENDORST	G 07414/002063

18N2/0522

LISA A HAILE
FISH & RICHARDSON
4225 EXECUTIVE SQUARE
SUITE 1400
LA JOLLA CA 92037

EXAMINER

KAUFMAN, C

ART UNIT PAPER NUMBER

1812

3

DATE MAILED:

05/22/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 9/11/96

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 2 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37-CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 17-28 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 17-28 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ -Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-892

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

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DETAILED ACTION

1. In paper number 2 filed 9/11/96, cancellation of claims 1-16, 29, and 30 was requested. Claims 1-16 have been canceled, however the application does not contain claims 29-30 so that these two claims were not canceled.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 17-19, drawn to a method of accelerating wound healing by contact with CTGF, classified in class 514, subclass 12.
- II. Claims 20-21, drawn to a method of diagnosing pathological states, classified in class 435, subclass 7.1.
- III. Claims 22-27, drawn to a method of ameliorating diseases with a CTGF reactive agent which is an antibody, classified in 435, subclass 145.1.
- IV. Claims 22-25 and 27-28, drawn to a method of ameliorating diseases with a CTGF

reactive agent which is an TGF β , classified in 514, subclass 12.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II, I and III, I and IV, II and III, and II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case each method uses different process steps and components, and is performed for a different purpose. Further, in terms of Invention I and Inventions III and IV, wound healing is not a disease even though wounds may be symptoms of a disease, wounds are not the cause (*e.g.*, a bacterial or viral infection or cancer/oncogene misexpression). For this reason, a method of wound healing is distinct from a method of ameliorating a disease. Also, CTGF is structurally and functionally distinct from an antibody

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directed to it and from TGF β . While CTGF and TGF β are classified the same, the compounds are patentably distinct because not only is their structure and function different, but also the literature search required for CTGF is different than for TGF β .

Inventions III and IV both drawn to the same method, however, Invention III uses an antagonist or antibody and Invention IV uses TGF β . The antibody and TGF β are structurally and functionally distinct. Additionally, while the antibody is a CTGF antagonist as claimed, TGF β is a CTGF agonist (p. 11, lines 23-25, of the specification).

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, and the search required for Inventions I-IV are not coextensive, restriction for examination purposes as indicated is proper.

4. A telephone call was made to Lisa Haile on 5/19/97 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

5. It is noted that parent application 08/386,680 of which the current application is a divisional, had claims 17-28 canceled prior to prosecution. Application 08/167,628, of which 08/386,680 is a divisional, had claims 17-28 restricted as set forth above.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Claire M. Kaufman, whose telephone number is (703) 305-5791. Dr. Kaufman can generally be reached Monday through Friday from 8:00AM to 4:30PM.

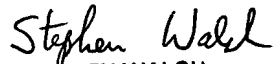
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Walsh, can be reached at (703) 308-2957.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

The Art Unit 1812 Fax Center number is (703) 308-0294. NOTE: If applicant *does* submit a paper by fax, the original signed copy should be retained by the applicant or applicant's representative. **NO DUPLICATE COPIES SHOULD BE SUBMITTED** so as to avoid the processing of duplicate papers in the Office. **Please** advise the examiner at the telephone number above before facsimile transmission.


cmk

May 20, 1997


STEPHEN WALSH
SUPERVISORY PATENT EXAMINER
GROUP 1800